



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/309,127	12/01/2011	Steven W. Lundberg	3431.014US1	1856

21186 7590 07/26/2017  
SCHWEGMAN LUNDBERG & WOESSNER, P.A.  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER
----------

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
----------	--------------

3689

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

07/26/2017

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com  
SLW@blackhillsip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* STEVEN W. LUNDBERG

---

Appeal 2015-000321  
Application 13/309,127  
Technology Center 3600

---

Before JOHN A. JEFFERY, BRUCE R. WINSOR, and  
JUSTIN BUSCH, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1, 3–6, and 8–10. Claims 2 and 7 were cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellant's invention is a patent management system that includes tools to help parties involved in a patenting process make decisions. The tools provide patent analytics information for facilitating prosecution of a patent manner by extracting and analyzing data from an external patent database. *See generally* Abstract; Spec. ¶¶ 12–13. Claim 1 is illustrative:

1. A computer-implemented method of generating patent prosecution analytics, comprising:

providing at least one processor to scrape data from an external patent database, the data containing information about office action activity and responses thereto for at least one patent matter stored in the database;

providing at least one processor to analyze the office action activity and responses thereto to identify at least instances in which a response has resulted in allowance of at least one claim in the at least one patent matter, or at least instances in which a response has not resulted in allowance of a claim in the at least one patent matter;

providing at least one processor to identify at least one Examiner or attorney associated with the instances of allowance or non-allowance;

providing at least one processor to create a prosecution profile for the Examiner or attorney based on the identified instances of allowance or non-allowance; and

identifying the grounds of rejection relied upon in the office action activity for at least one patent matter and, based on the grounds of rejection, grouping the instances of allowance or non-allowance in the created profile for the Examiner or attorney.

#### RELATED APPEALS

Appellant did not identify any related appeals. *See* App. Br. 3.

However, we note that there are at least twenty-eight (28) related appeals, which are:

<u>Appeal No.</u>	<u>Application No.</u>	<u>Decided/Status</u>
2009-005709	10/128,141	Decision mailed Mar. 22, 2010
2009-006404	10/874,486	Decision mailed July 30, 2010
2011-009966	11/061,383	Decision mailed Jan. 29, 2014
2012-004166	11/061,312	Decision mailed Oct. 31, 2014
2015-003180	13/309,039	Decision mailed Sept. 21, 2016
2015-000319	13/309,080	Decision mailed May 25, 2016
2015-007422	13/309,146	Decision mailed May 27, 2016

Appeal 2015-000321  
Application 13/309,127

2016-000912	13/309,060	Pending
2016-001687	11/888,632	Decision mailed Jan. 17, 2017
2016-002121	13/309,200	Pending
2016-002680	13/310,279	Pending
2016-002792	12/605,030	Pending
2016-006797	13/310,368	Pending
2016-007186	13/573,803	Pending
2016-007415	13/464,598	Pending
2016-007623	13/408,877	Pending
2016-007787	13/310,322	Pending
2016-008030	13/253,936	Pending
2017-000280	13/408,917	Pending
2017-000386	11/098,761	Pending
2017-002337	14/010,376	Pending
2017-003702	14/483,903	Pending
2017-003815	14/094,542	Pending
2017-004158	14/010,391	Pending
2017-004159	14/010,380	Pending
2017-004188	14/010,400	Pending
2017-006390	13/409,189	Pending
2017-006642	13/310,452	Pending

### THE REJECTIONS

The Examiner rejected claims 1, 3–6, and 8–10 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 2–3.<sup>1,2</sup>

The Examiner rejected claims 1, 3–6, 8, and 9 under 35 U.S.C. § 103(a) as unpatentable over Abu-Ghazalah et al. (US 2012/0130773 A1; May 24, 2012 (filed Nov. 15, 2011)), and Kahn (US 2009/0055721 A1; Feb. 26, 2009). Final Act. 2–10.

The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as unpatentable over Abu-Ghazalah, Kahn, and Oppedahl et al. (US 6,789,092 B1; Sept. 7, 2004). Final Act. 10–15.

### THE § 101 REJECTION

The Examiner finds that “[t]he claim(s) are directed to the abstract idea of analyzing patent prosecution information.” Ans. 2–3. The Examiner further finds that “[t]he additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: mere instructions to implement the idea on a computer.” *Id.* at 3. Given these findings, the Examiner concludes the claims are ineligible under § 101

Appellant argues that the claimed invention is not directed to an abstract idea because the Examiner does not explain how “analyzing patent

---

<sup>1</sup> Throughout this opinion, we refer to (1) the Final Rejection mailed October 22, 2013 (“Final Act.”); (2) the Appeal Brief filed April 30, 2014 (“App. Br.”); (3) the Examiner’s Answer mailed July 31, 2014 (“Ans.”); and (4) the Reply Brief filed September 30, 2014 (“Reply Br.”).

<sup>2</sup> The Examiner designates the § 101 rejection as a new ground of rejection in the Answer.

prosecution information” applies to the excluded concepts identified in *Alice* to support a *prima facie* case of patent-ineligibility. Reply Br. 3. Appellant further argues, even if the claims are directed to an abstract idea, “the claims amount to significantly more by creating profiles for Examiners and attorneys including allowance and non-allowance rates based on grounds of rejection.” *Id.*

### ISSUE

Has the Examiner erred in rejecting claim 1 by concluding that the method of generating patent prosecution analytics is directed to ineligible subject matter under § 101? This issue turns on whether the claimed invention is directed to a patent-ineligible abstract idea and, if so, whether elements of the claim—considered both individually and as an ordered combination—transform the nature of the claim into a patent-eligible application of that abstract idea.

### ANALYSIS

In *Mayo Collaborative Services v. Prometheus Laboratories., Inc.*, 566 U.S. 66, 71–73 (2012), the Supreme Court established an analytical framework under § 101 to distinguish patents that claim patent-ineligible laws of nature, natural phenomena, and abstract ideas—or add too little to such underlying ineligible subject matter—from those that claim patent-eligible applications of those concepts. To determine whether claims are patent eligible under § 101, we apply the Supreme Court’s two-step test articulated in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014). First, we determine whether the claims are directed to a patent-ineligible

concept: laws of nature, natural phenomena, and abstract ideas. *Id.* at 2354–55. Claim 1 is directed to a method, which is one of the four statutory classes. Following the Court’s guidance, we turn to the first step of the *Alice* analysis to determine if the claim is directed to one of the judicial exceptions, i.e., an abstract idea. If so, we then proceed to the second step and examine the elements of the claim—both individually and as an ordered combination—to determine whether the claim contains an “inventive concept” sufficient to transform the claimed abstract idea into a patent-eligible application. *Id.* at 2357.

#### *Prima Facie Case*

At the outset, we note Appellant’s contention that the Examiner has failed to make a *prima facie* case of unpatentability is unavailing. As the Federal Circuit has clarified,

the PTO carries its procedural burden of establishing a *prima facie* case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. That section “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

*In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (brackets in original).

Here, we find the Examiner’s rejection satisfies the initial burden of production by identifying that “[t]he claim(s) are directed to the abstract idea of analyzing patent prosecution information” (Ans. 3) (part 1 of the *Alice* analysis) and that “[t]he additional element(s) or combination of elements in

the claim(s) other than the abstract idea per se amount(s) to no more than: mere instructions to implement the idea on a computer” (*id.*) (part 2 of the *Alice* analysis). Accordingly, the Examiner has set forth the statutory basis for the rejection (a judicial exception to 35 U.S.C. § 101) and explained the rejection in sufficient detail to permit Appellant to respond meaningfully. Thus, we find that the Examiner set forth a *prima facie* case of ineligibility.

### *Alice Step One*

The Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“[p]henomena of nature . . ., mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” (emphasis added)). Additionally, mental processes remain unpatentable even when automated to reduce the burden on the user of what once could have been done with pen and paper. *CyberSource*, 654 F.3d at 1375 (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”).

Here, we agree with the Examiner (Ans. 2–3) the claims are directed to an abstract idea. Specifically, applying *Alice* step one, we find under a broad but reasonable interpretation, claim 1 is directed to an abstract concept that can be performed entirely mentally except for “providing at least one



processor” recited in four of the five steps. That is, a human can mentally analyze office action activity and responses thereto, scraped from an external patent database, by identifying (1) instances in which a response resulted in allowance or not; and (2) at least one Examiner or attorney associated with the identified instances (or use pen and paper to do so). Further, a human can mentally create a prosecution profile for the Examiner or attorney based on the identified instances, and group the identified instances in the created profile based on identified grounds of rejection (or use pen and paper to do so). Therefore, when read as a whole, claim 1 is simply directed to analyzing patent prosecution information, which can be performed mentally or with pen and paper.

That claim 1 adds “providing at least one processor” to perform four of the five method steps in claim 1 does not change our conclusion. We reach the same conclusion despite claim 1 adding an “external patent database” from which information about office action activity and responses thereto is scraped. Such data gathering is insignificant extra-solution activity that is insufficient to render the claim patent-eligible. *See In re Bilski*, 545 F.3d 943, 962–63 (Fed. Cir. 2008), *aff’d on other grounds*, 561 U.S. 593 (2010).

Nor does the claimed invention improve the computer’s functionality or efficiency, or otherwise change the way the computer functions. *Cf. Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). Thus, claim 1 merely recites a generic computer to perform four of the five steps, which cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2358. In other words, merely reciting an abstract idea while adding the words “apply it with a computer” does not

render an abstract idea non-abstract: there must be more. *See id.* at 2359. “[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible. The bare fact that a computer exists in the physical rather than purely conceptual realm is beside the point.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (internal citations and quotation marks omitted).

Appellant’s contention that the rejection does not adequately explain how “analyzing patent prosecution information” applies to the excluded concepts identified in *Alice* (Reply Br. 3) is also unavailing. As in *Alice*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of risk hedging in *Bilski v. Kappos*, 561 U.S. 593 (2010), and the concept of analyzing patent prosecution information at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice*, 134 S. Ct. at 2357.

#### *Alice Step Two*

Turning to the second step of the *Alice* analysis, because we find that claim 1 is directed to an abstract idea, the claims must include an “inventive concept” in order to be patent-eligible, i.e., there must be an element or combination of elements that is sufficient to ensure that the claim in practice amounts to “significantly more” than the abstract idea itself. *Alice*, 134 S. Ct. at 2357.

According to Appellant, claim 1 solves a specific problem in a technical field by creating profiles for Examiners and attorneys that include allowance and non-allowance rates based on a grounds of rejection. Reply Br. 3. Appellant concludes the claims are significantly more than analyzing patent prosecution information. *Id.* We disagree. We note the Supreme Court has rejected the notion that “‘implement[ing] a principle in some specific fashion’ will ‘automatically fal[l] within the patentable subject matter of § 101.’” *Alice*, 134 S. Ct. at 2358 (alterations in original) (citation omitted). In addition, the step that Appellant identifies (i.e., creating profiles for Examiners and attorneys that include allowance and non-allowance rates based on a grounds of rejection) is not only incommensurate with the language of claim 1 that recites no such rates,<sup>3</sup> the identified step is merely part of the abstract idea itself of mentally analyzing patent prosecution information (or using pen and paper to do so).

As discussed above, merely reciting a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *Id.* Accordingly, claim 1 amounts to nothing significantly more than instructions to apply the abstract idea of analyzing patent prosecution information using an unspecified, generic computer to perform some—but not all—of the method steps.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 3–6 and 8–10 not argued separately with particularity.

---

<sup>3</sup> Notably, claim 1 lacks the term “rates,” unlike claims 3, 4, 8, and 9 that recite prosecution success rates.

### THE OBVIOUSNESS REJECTION

Regarding claim 1, the Examiner finds that Abu-Ghazalah discloses many recited elements of independent claim 1 including, among other things, “parsing [received office action] information to determine at each stage of the prosecution (i.e. non-final office action, final office action, [request for continued examination (RCE)], etc[.]” Final Act. 3 (citing Abu-Ghazalah ¶¶ 76–107, 120). The Examiner also finds Abu-Ghazalah discloses “grouping instances of allowances based upon prosecutions activities such as Non-Final Office Action, Final Office Action, Amendment After Final, RCE, etc[.]” *Id.* at 4 (citing Abu-Ghazalah Figure 11). Although the Examiner acknowledges that Abu-Ghazalah does not further parse the office action information to determine the grounds of rejection for the prosecution stage, the Examiner cites Kahn as teaching this feature. Final Act. 4 (citing Kahn ¶ 26; Figure 3). The Examiner concludes

[a]nalyzing the grounds of rejection, as taught by Kahn, would have been an obvious substitution for the general information of Abu-Ghazalah et al. since such a substitution would have resulted in a more robust analysis system that would provide more detailed information that would better describe the particular outcome of an application.

Final Act. 5.

Appellant argues that the cited prior art does not teach or suggest “identifying the grounds of rejection relied upon in the office action activity for at least one patent matter and, based on the grounds of rejection, grouping the instances of allowance or non-allowance in the created profile for the Examiner or attorney,” as recited in claim 1. App. Br. 9–10; Reply Br. 4–5. Specifically, Appellant argues that Abu-Ghazalah does not

disclose “the general merits (much less the specific grounds of rejection) of an office action,” and, therefore, Abu-Ghazalah does not disclose anything based on such information (App. Br. 9; *see also id.* at 10) such as grouping such information (*see id.* at 11). Appellant also argues that although Kahn may identify a ground of rejection, Kahn does not disclose grouping instances of allowance or non-allowance based on the identified ground of rejection. *Id.* at 10–11. Appellant concludes the rationale to substitute Abu-Ghazalah’s alleged “general information” with Kahn’s identified grounds of rejection is improper. *Id.*; Reply Br. 5.

#### ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Abu-Ghazalah and Kahn collectively would have taught or suggested identifying a grounds of rejection relied upon in office action activity for at least one patent matter and, based on the grounds of rejection, grouping instances of allowance or non-allowance in a created profile for the Examiner or attorney?

#### ANALYSIS<sup>4</sup>

On this record, we see no error in the Examiner’s obviousness

---

<sup>4</sup> Although claim 9 is indefinite because it depends from cancelled claim 7, we nonetheless presume that claim 9 was intended to depend from independent claim 6. Dependent claim 5/2 is also indefinite because claim 5 depends from “any one of claims 1 to 4” (App. Br. 15), which includes depending from canceled claim 2. We likewise presume that claim 5 was intended to depend from any one of claims 1, 3, and 4.

rejection of claim 1. First, Appellant's contention that Abu-Ghazalah does not disclose the general merits of an office action (App. Br. 9) is unavailing. Abu-Ghazalah is generally directed to increasing the probability of allowance of a patent application by predicting a next course of action. Abu-Ghazalah, Abstract. Paragraph 98 of Abu-Ghazalah defines a "step distribution" as a percentage of allowed applications following each type of prosecution step (e.g., a non-final rejection, final rejection, or RCE). For example, paragraph 98 of Abu-Ghazalah provides

if 100 cases were allowed, 14 following the initial application, 38 following a response to a non-final rejection, 10 following a response to a final rejection, 23 following an RCE and 15 following an appeal, the distribution would be 14%, 38%, 10%, 23% and 15% for the Application, Response to Non-Final Rejection, Response to Final Rejection, RCE and Appeal respectively.

"Second or any subsequent actions on the merits shall be final, except" in limited circumstances. MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 706.07 (9th ed. Rev. 07.2015, Nov. 2015). Accordingly, Abu-Ghazalah's final rejection is a second or subsequent action on the merits of an examined patent application.

Further, we note that to the extent Appellant equates the general merits of an office action to a grounds of rejection in the office action, such a contention is unavailing because it is not germane to the reason Abu-Ghazalah was cited. In particular, the Examiner relies on Abu-Ghazalah for teaching identifying general information of each prosecution stage (e.g., a final rejection) relied upon in the office action activity for at least one patent matter and, based on the general information of each prosecution stage,

grouping the instances of allowance or non-allowance in the created profile for the Examiner or attorney. *See* Final Act. 3–5; *see also* Ans. 3–6.

We likewise find unavailing Appellant’s contention that Kahn does not group instances of allowance or non-allowance based on an identified ground of rejection (App. Br. 10–11) because it is not germane to the reason Kahn was cited, namely for teaching identifying a grounds of rejection relied upon in office action activity. *See* Final Act. 4–5; *see also* Ans. 4–6. And even assuming, without deciding, that Khan does not mention profiles as Appellant contends (Reply Br. 5), Appellant’s argument in this regard is similarly unavailing, for here again, Khan was not cited for that feature. *See* Final Act. 3–4.

In short, Appellant’s arguments regarding the individual shortcomings of the cited references do not show nonobviousness where, as here, the rejection is based on the cited references’ collective teachings. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Lastly, we find unavailing Appellant’s contention that the Examiner’s articulated rationale to combine the references, namely to provide a more robust analysis system, allegedly “comes directly from the claims” because the Examiner provided no reference to support this conclusion. Reply Br. 5. It is well settled that a reason to combine references need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006). Therefore, to the extent that Appellant contends that the Examiner’s rationale to combine

the references must be articulated in a prior art reference (*see* Reply Br. 5), such a contention runs counter to established precedent.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 3–6, and 8–10 not argued separately with particularity.

#### CONCLUSION

The Examiner did not err in rejecting claims 1, 3–6, and 8–10 under §§ 101 and 103.

#### DECISION

The Examiner's decision in rejecting claims 1, 3–6, and 8–10 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED